

REMARKS

Claims 1-14 and 27-33 remain pending. No amendments have been presented.

Claim Rejections -- 35 U.S.C. § 103

Claims 1-14 and 27-33 have been rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 6,312,540 to Moyes in view of U.S. Patent No. 2,675,338 to Phillips. Applicant respectfully traverses this rejection.

Applicant notes that in the previous Office Action the Section 103(a) rejection was based on Phillips as the so-called primary reference and Moyes as the so-called secondary reference. The Examiner has reversed the order of these references in the final Office Action. Applicant respectfully submits that the flipping of the applied art does not alter the earlier conclusion that a person of ordinary skill in the art would not have found it obvious to combine these patents.

The so-called primary reference Moyes presses composite blanks, a skill discussed in the background section of the present application at page 4, lines 13-20, reproduced below:

Attempts to reform, or "post-form", a flat pressed wood composite blank into a molded blank having contoured portions have had varying results. For example, methods for reforming a wood composite blank are disclosed by Moyes in U.S. Patent Nos. 6,312,540 and 6,079,183, the disclosures of which are incorporated herein by reference and the assignee of which is the assignee hereof. Wood composite blanks are comprised of reconstituted wood fibers that have been broken down into small wood chips and/or wood fiber particles. These particles are bonded together with a synthetic resin to form the composite blank.

The post-forming operation of Moyes is premised on the flowability of the wood chips/particles in a resin for repositioning into a desired configuration. The resulting

door skin has an appearance that does not closely resemble natural solid wood, as evidenced by Moyes' use of laminated crepe paper or phenolic resin crepe paper to conceal the door skin surfaces. *See* Col. 4, lines 65-67 of Moyes.

Unlike the free-flowing nature of the composite materials of Moyes, plywood has relatively non-disrupted and unreduced size wood fibers in solid wood plies. The solid wood ply or plies of Phillip's plywood do not freely flow in a resin in the same manner as wood fibers of a composite material. Given the fundamental differences between composite materials and plywood, a person of ordinary skill in the art would not have had a reasonable expectation that the composite-material treatment process of Moyes, which is based on the flow of resin and wood fibers and the disruption of lignin by fiber reduction, could be applied successfully to a plywood board such as disclosed in Phillips.

In the final Office Action, the Examiner states that "Moyes does not restrict the wood material to just composite wood with a resin but throughout the disclosure it stated 'flat blank ... preferably a wood composite' (as seen at least on Col. 5, lines 58-62)." Applicant respectfully disagrees. At column 1, first paragraph, where the field of invention is typically recited in a patent application (MPEP § 608.01(c)), Moyes teaches that its "disclosed invention is to a method for manufacturing a molded door skin from a solid flat wood composite material" At column 2, lines 32-37 in what is clearly part of the summary of the invention, Moyes describes as the "primary object" of its invention the provision of "a method of manufacturing a molded door skin from a flush wood composite blank." Applicant respectfully submits that the material that Moyes repeatedly references "throughout the disclosure" is composite wood.

Applicant respectfully submits that the Examiner's bestowal of a broad disclosure to Moyes premised on the word "preferably" is improper. Chisum, *Chisum on Patents*, § 5.03[3][a][i] ("In *Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocure, Inc.* [796 F.2d 443 (Fed Cir.) 1986], the Federal Circuit held that a single line in a prior art reference should not be taken out of context and relied upon with the benefit of hindsight to show obviousness. Rather, a reference should be considered as a whole") If during patent prosecution Moyes had attempted to expand its claims beyond "wood composites," the Patent Office surely would have objected to such an amendment under 35 U.S.C. § 112, first paragraph. The Moyes patent must be interpreted in the same manner when cited as prior art here.

The Examiner next alludes that because "Moyes" allegedly does not teach away from the combination, the rejection is proper. Applicant respectfully submits that the "teaching away" factor is not a prerequisite to non-obviousness, and its absence does not mandate or sanction the application of Section 103(a). Even if a reference does not teach away, it must be considered as a whole. See *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). A person reading Moyes "as a whole" would have concluded that its teachings are limited to the molding of flowable wood composite materials.

Finally, the Examiner asserts that plywood boards such as disclosed in Phillips may have a resin core, and therefore would be deemed as flowable. However, even assuming *arguendo* that Phillips discloses a plywood resin core, the plywood also will comprise outer layers made of material that is not flowable. The core is pressed together with these outer layers, not in isolation from the outer layers in separate pressing steps.

Simply because a skilled artisan might have viewed the core as flowable does not mean that the skilled artisan would have viewed the outer layers as flowable or suitable for the Moyes process.

Accordingly, Applicant respectfully requests that the obviousness rejection be withdrawn and claims 1-14 and 27-33 be allowed.

Additionally, claims 4-6 and 28-33 recite that the conditioning step is performed with steam. Applicant respectfully submits that Phillips expressly teaches away from use of high temperature treatment of any kind prior to cure of the thermosetting resinous component of its adhesive material.¹ Specifically, Phillips states at column 3, lines 1-7:

One may use, however, some small measure of heat if desired **but under no circumstances should the temperature be permitted to rise above about 50°C.** This is, of course, during the preliminary step wherein the structure is substantially flat.

(Emphasis added.)

The Examiner responded to this argument in the Office Action by asserting that Moyes has been relied upon for teaching a molding process, whereas “Phillips is relied upon for the teaching of a plywood door skin that is capable of [being] molded and not the specific molding process.” (Page 4, lines 5-6.)

Moyes teaches a molding process in which a blank is maintained at a temperature

¹ A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant.” *In re Icon Health & Fitness, Inc.*, 2007 U.S. App. LEXIS 18244 (Fed. Cir. 2007), citing *In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994). When the prior art teaches away from a combination, that combination is more likely to be nonobvious. *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1739-40 (U.S. 2007). In fact, where the prior art discourages from attempting the substitution suggested by the applicant, such teachings are “strongly probative of nonobviousness”. *Kloster Speedsteel AB v. Crucible Inc.*, 230 U.S.P.Q. 81, 86 (Fed. Cir. 1986), *cert. denied*, 479 U.S. 1034 (1987).

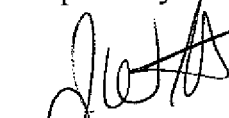
of 80-100°C. (Column 6, lines 50-52; final Office Action page 5, lines 3-6.) Phillips discloses plywood, but characterizes the plywood as having a certain composition and properties that make its plywood absolutely unsuitable (“under no circumstances”) for heating above 50°C. Given this teaching, a person of ordinary skill in the art practicing the method of Moyes would not have selected a material having properties that are not suited for the Moyes process. Such a selection would have been counterintuitive.

For these additional reasons, Applicant respectfully submits that the Section 103(a) rejection of claims 4-6 and 28-33 is misplaced, and respectfully requests withdrawal of the same.

Conclusion

Applicant respectfully requests withdrawal of all rejections and allowance of the pending claims in light of the remarks and amendments herein. Should it be determined that any fees are due in connection with this filing, then please debit Account No. 50-0548 and notify the undersigned.

Respectfully submitted,



Joseph W. Berenato, III
Registration No. 30,546

September 21, 2009

Berenato, White & Stavish, LLC
6550 Rock Spring Drive, Ste. 240
Bethesda, Maryland 20817
Telephone: (301) 896-0600
Facsimile: (301) 896-0607